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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,607	12/13/2000	George M. Brookner	770P009578-US	2526

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PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,607

Applicant(s)

BROOKNER ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-53 and 76-95 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 14-41, 54-61, 63-75, 96, 99-104, 107 and 108 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 13, 62, 97, 98, 105 and 106 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. This application does not contain an Abstract of the Disclosure as required by 37 C.F.R. § 1.72(b). An Abstract on a separate sheet is required.
3. The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
 - 3.1 Misnumbered claims 100-109 have been renumbered as 99-108.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
5. Claims 15-41, 64-76, 99-103 & 108 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - 5.1 Claims 15-41, 64-76, 99-103 & 108 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:
 - A) in regard to claims 15-28, 64-75, 99-100 & 108, the preamble of claim 15 indicates that the purpose of this claim is to conduct a transaction to purchase a ticket, however, these claims merely recite a system that:
 - (1) includes a communications link with a ticket server;
 - (2) a device for entering preference data; and

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(3) a processor that performs a funds transfer and produces an indicia that includes various types of information/data as proof of payment for the ticket;

however, these claims fails to recite that either:

- (1) the indicia is the purchased ticket; or
- (2) the indicia is exchangeable for the purchased ticket.

these claims clearly fail to conduct a transaction to purchase a ticket.

B) in regard to claims 29-33, 76 & 101-103, the preamble of this claim indicates that the purpose of this claim is to generate a indicium indicative of payment, however, this claim merely recites:

- (1) a printed head for print information; and
- (2) a sensor encapsulated in potting material for detecting an intrusion to the connection supplying data to the print head, where a detected intrusion terminates the operation of the print head;

however, since these claims fails to recite that the indicia is either:

- (1) printed;
- (2) generated; or
- (3) required to be associated with any type of payment,

these claims clearly fail to accomplish the intended purpose of the claimed invention.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

5.2 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6.1 Claims 15, 16, 22, 23, 26-28, 64, 65, 74 & 75 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Arent (6,018,724).

6.1.1 In regard to claims, 15, 16, 22, 64 & 65, Arent ('724) discloses a computer 1000 that includes a processor 1013, an user interface (1010, 1011, 1017) and communications interface 1020. Where processor 1013 communicates with a remote server 1026 via interface 1020, receives an preference from the user via the user interface and communicates payment information as a funds transfer via interface 1020. If the transaction is successful, then computer 1000 of Arent ('724) receives a printable indicia (see column 12, lines, 30-31, "PAID stamp to reassure user of a successful transaction and approval of payment."). Further, the system of Arent ('724) can be used to purchase tickets, (see column 17, lines 61-62, "Get 500 frequent flier miles if you buy you tickets online").

6.1.2 In regard to claims 22 & 23, the certificate of Arent ('724) contains user defined encrypted information (520), such as a password, pin or biometric or signature.

6.1.3 In regard to claims 26-28, 74 & 75, the payment transaction requires the use of an accounting unit, that keeps track of available funds and dispensed funds.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Arent (6,018,724) as applied to claims 15, 16, 22, 23, 26-28, 64, 65, 74 & 75, and further in view of equivalent alternatives.

7.1.1 In regard to claim 17, since it is common practice to for an customer to require/produce a hard copy of any receipts received by a vendor on a suitable media, where the produced receipt may be used as evidence when acquiring the purchased item or to resolve a dispute about the transaction. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the printable indicia could be produced on any suitable media, including label stock.

7.2 Claims 18-22, 24 & 66-72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arent (6,018,724) as applied to claims 15, 16, 22, 23, 26-28, 64, 65, 74 & 75, and further in view of Kara (WO97/14117).

7.2.1 In regard to claims 18-22 & 24, although the certificate of Arent ('724) includes in formation defined by the user, for example a pin or password or biometric, the certificate does not contain a barcode. However, in the environment of providing proof of payment, Kara ('117) discloses the use of a machine readable two-dimensional barcode that includes information about the user and proof of payment. Since, the paid symbol of Arent ('724) is proof of payment and contains encrypted information, it would have been obvious to one of

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ordinary skill at the time the invention was made that the information contained in the printable indicia could be produced using any suitable and equivalent manner.

7.3 Claim 25 & 73 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Arent (6,018,724) as applied to claims 15, 16, 22, 23, 26-28, 64, 65, 74 & 75, and further in view of equivalent alternatives.

7.3.1 In regard to claim 25, since the system of Arent ('724) can be used to purchase tickets, it would have been obvious to one of ordinary skill at the time the invention was made that any type of ticket requiring proof of payment, such as a lottery ticket could be purchased by the system of Arent ('724).

7.4 Claims 1-9, 11, 14, 54-61, 63, 96 & 104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Calvi (4,580,144) or Sansone et al (4,673,303) or Gilham (5,122,967 or 5,200,903 or 5,408,416) or Abumehdi (5,508,933) or Naclerio et al (5,583,779) or Windel et al (5,680,463 or 5,712,916 or 5,734,723).

7.4.1 In regard to claims 1, 2, 4-7, 11, 14, 54, 55, 58, 63, 96 & 104 anyone of either Calvi ('144) or Sansone et al ('303) or Gilham ('967 or '903 or '416) or Abumehdi ('933) or Naclerio et al ('779) or Windel et al ('463 or '916 or '723) disclose a postage metering system that dispenses and accounts for the postage used by the system. Once postage is to be dispensed, these systems combine variable and fixed data to form the postage indicia and mail piece. Next, the data is printed on either a strip of tape or the mail piece.

7.4.2 It is noted that one of ordinary skill would know that:

A) the postage indicia generated by these system must conform the any and all applicable rules or regulations of the governing Postal Authority.

B) the tape may contain preprinted fixed postage data.

C) a postage indicia is not printed until after the meter has accounted for the dispensed postage.

D) the accounting unit and printer are separate units and hence the accounting unit is external to the printer.

E) a standard printer prints in at least two color, the absence of color and the presence of color, when forming an image.

F) common ordinary labels deform/bend under stress.

7.4.3 In regard to claims 3, 56 & 57, since the weight is a vital factor in determining postage, it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Calvi ('144) or Sansone et al ('303) or Gilham ('967 or '903 or '416) or Abumehdi ('933) or Naclerio et al ('779) or Windel et al ('463 or '916 or '723) require the use of a scale or other weight determining means.

7.4.4 In regard to claims 6-9 & 59-61, it is noted that the label stock/tape is generally self adhesive and the amount dispensed is related to the amount of information to be printed so that there is not a waste of the label stock or self-adhesive tape.

8. The following is an Examiner's Statement of Reasons for Allowance:

A) the prior art, for example, either Calvi (4,580,144) or Sansone et al (4,673,303) or Gilham (5,122,967 or 5,200,903 or 5,408,416) or Abumehdi (5,508,933) or Naclerio et al (5,583,779) or Windel et al (5,680,463 or 5,712,916 or 5,734,723) discloses a postage metering system that dispenses and accounts for the postage used by the system. Once postage is to be dispensed, these systems combine variable and fixed data to form the postage indicia and mail piece. Next, the data is printed on either a strip of tape or the mail piece.

B) however in regard to claims 10 & 62, the prior art does not teach or suggest the printing of the indicia on the adhesive side of the self adhesive label.

C) however in regard to claim 12, the prior art does not teach or suggest the use of label stock/tape that disintegrates under stress. Claim 13 is allowable for the same reason.

D) however in regard to claims 29 & 76, the prior art does not teach or suggest the disabling of the printer when tampering has been detected. Claims 30-33, 78-83 & 101-103 are allowable for the same reason.

E) however in regard to claims 34 & 77, the prior art does not teach or suggest the printing of a non-fluorescent postage indicia on a fluorescent medium. Claims 35-41 & 78-83 are allowable for the same reason.

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F) however in regard to claims 42 & 84, the prior art does not teach or suggest the printing of machine readable information at two separate locations on the mail item, where one of the machine readable information is for error correction. Claims 43-49 & 85-91 are allowable for the same reason.

G) however in regard to claims 50 & 92, the prior art does not teach or suggest the printing of machine readable information at two separate locations on the mail item where one of the machine readable portion includes an indication that associates the two machine readable portions. Claims 51-53 & 93-95 are allowable for the same reason.

H) however in regard to claims 97, 98, 105 & 106, the prior art does not teach or suggest the use of a postage metering system to generate and purchase either lottery tickets (claims 97 & 105) or theater tickets (claims 98 & 106). Claims 15-28, 65-75, 99, 100, 107 & 108 are allowable for the same reason.

G) however in regard to claim 100, the prior art does not teach or suggest the use of a postage indicia a proof of payment for a ticket.

9. The examiner has cited prior art of interest, for example:

A) Gilham (EP 0376576), which discloses the printing of postage indicia on label stock.

B) Auguin et al (FR 2646943), which disclose printing a postage indicia containing fixed and variable information on a strip.

C) either Roth et al or Lamparter, which discloses the use of digital printing to print variable and fixed data.

D) Gold, which disclose purchasing tickets on line.

E) Brookner et al (WO 99/66456), which discloses using a 2-dimensional barcode as part of a postage indicia and proof of payment.

F) Sansone (6,188,996), which disclose the preprinting of some of the information contained in a postage indicia.

10. Claims 10, 62, 97, 98, 105 & 106 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Claim 100 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

06/26/03


Edward R. Cosimano
Primary Examiner A.U. 3629